REMARKS

The Non-final Office Action, mailed December 26, 2007, considered claims 7–12, and 19–30. Claims 10–11, 22–23, and 28–29 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, in that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 7, 9–12, 19, and 21–24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein, U.S. Patent Pub. No. 2002/0133507 (filed Mar. 29, 2002) (hereinafter Holenstein), in view of Neeman, U.S. Patent No. 5,588,147 (filed Jan. 14, 1994) (hereinafter Neeman), and further in view of Gupta, Brush, Bargeron and Cadiz, *Robust Annotation Positioning in Digital Documents* (published Sep. 22, 2000) (hereinafter Gupta). Claims 8 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein, in view of Neeman, further in view of Gupta, and yet further in view of Fujihara, U.S. Patent Pub. No. 2002/0191452 (filed) (hereinafter Fujihara). Claims 25 and 27–30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein, in view of Souder, U.S. Patent No. 5,806,074 (filed Jan. 14, 1994) (hereinafter Souder), further in view of Neeman, and yet further in view of Gupta. Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Holenstein, in view of Souder, further in view of Neeman, and yet further in view of Gupta and further in view of Fujihara.[1]

By this response, claims 7 and 19–24 are amended and claims 25–30 are cancelled.[2] Claims 7–12 and 19–24 remain pending. Claims 7 and 19 are independent claims which remain at issue. Support for the amendments may be found within Specification ¶¶ 206–216 and Fig's 17 and 26.[3]

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[1] Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

[2] The amendments and remarks presented herein are consistent with the information presented by telephone by patent attorney John Bacoch (reg. no. 59,890) and attorney Thomas Bonacci.

[3] However, it should be noted that the present invention and claims as recited take support from the entire Specification. As such, no particular part of the Specification should be considered separately from the entirety of the Specification.

As reflected in the claims, the present invention is directed generally toward methods and computer program products for reconciling data structures used in processing electronic ink and document annotations. Claim 7 recites, for instance, in combination with all the elements of the claim, a method of reconciling two data structures. The data structures each comprise a hierarchical tree of nodes. The first data structure comprises an analysis context object. The second data structure comprises a document independent analysis context object. The method includes determining whether each node in the second data structure has received a change from a corresponding node in the first data structure. For such determined node, access is attempted for the corresponding node in the first data structure. When inaccessible, the change is prevented in the second data structure. When accessible, it is determined when the change to the second data structure creates a discretionary collision and when the change to the second data structure creates a mandatory collision.

A mandatory collision occurs when it is impossible to apply a change made to the document independent analysis context object by an analysis process to the analysis context object for a current state. A discretionary collision occurs when a value has changed in the analysis context object that is related to a value changed in the document independent analysis context object by the analysis process, but other constraints of the analysis context object allow the application of the change made by the analysis process to the analysis context object.

When the change to the second data structure creates a discretionary collision, it is determined whether the discretionary collision is forbidden by collision criteria. When the discretionary collision is not forbidden by the collision criteria, the change is made to the corresponding node in the first data structure. When the discretionary collision is forbidden by the collision, the change is prevented from occurring.

Independent claim 19 recites a computer program product embodiment of the method of claim 7.

Each of the pending independent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Holenstein, in view of Neeman, and in view of Gupta. Claims 1 and 19 have now been amended and the Applicants submit that Holenstein, Neeman, and Gupta fail to teach or suggest all the limitations of the independent claims as now presented herein.

Holenstein discloses methods for collision avoidance in database replication systems. *See* Holenstein, Abstract. Neeman discloses a replication facility for the replication of files or

portions of files. *See* Neeman, Abstract. Gupta discloses the results of two studies which examined user expectations for annotation positioning in modified documents and how users reacted to lost annotations. *See* Gupta, Abstract.

However, the prior art fails to teach or suggest first and second data structures comprising a hierarchical tree of nodes, the first data structure comprising an analysis context object and the second data structure comprising a document independent analysis context object. Further, the prior art fails to teach or suggest for each node of the second data structure, determining whether the node has received a change from a corresponding node in the first data structure. The prior art also fails to teach or suggest when a corresponding node in the first data structure is accessible, determining when the change to the second data structure creates a discretionary collision and determining when the change to the second data structure creates a mandatory collision.

The prior art also fails to teach or suggest that mandatory collisions occur when it is impossible to apply a change made to the document independent analysis context object by an analysis process to the analysis context object for a current state. The prior art also fails to teach or suggest that a discretionary collision occurs when a value has changed in the analysis context object that is related to a value changed in the document independent analysis context object by the analysis process, but other constraints of the analysis context object allow the application of the change made by the analysis process to the analysis context object.

Because of at least the noted distinctions, inter alia, the Applicants submit that the prior art fails to teach all the limitations of independent claims 7 and 19 as now presented herein. Accordingly, a rejection under 35 U.S.C. § 103 would be improper and should be withdrawn. Correspondingly, the Applicants respectfully request favorable reconsideration of the claims as now presented herein.
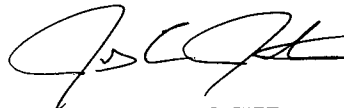
In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any

Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 26th day of June, 2008.

Respectfully submitted,

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